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Supreme Court, U.S.
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JAMES H. McKENNEY,
Clerk.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1889.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,
Petitioner,

vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

PETITION.

JOHN G. CARLISLE,
WM. McADOO,
R. B. McMASTER,
Counsel for Petitioner.

C. G. Burgoyne, Walker and Centre Streets, N. Y.

In the Supreme Court of the United States.

OCTOBER TERM, 1899.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,
Petitioner,

vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

Petition for Writ of Certiorari requiring the United States Circuit Court of Appeals for the Second Circuit to certify to the United States Supreme Court for its review and determination the case of Rahtjen's American Composition Company, Appellant, vs. Holzapfel's Compositions Company, Limited, Appellee.

TO THE HONORABLE SUPREME COURT OF THE UNITED STATES:

The Petition of Holzapfel's Compositions Company, Limited, respectfully shows to this Honorable Court as follows:

I. Your petitioner is, and at the times hereinafter mentioned was, a corporation organized under the

laws of the Kingdom of Great Britain, carrying on business in the said Kingdom of Great Britain and in the City of New York, State of New York, and elsewhere.

II. That on the 11th day of August, 1898, the Rahtjen's American Composition Company, a corporation organized under the laws of the State of New York, and the respondent herein, filed its bill of complaint against said Holzapfel's Compositions Co., Ltd., your petitioner herein, for infringement of the alleged trade-mark "Rahtjen" applied to a composition or paint for ships' bottoms, and for unfair competition in trade. On the 22nd day of October, 1898, the said Rahtjan's American Composition Co., the respondent herein, filed its amended bill of complaint in said suit against Holzapfel's Compositions Company, Ltd., your petitioner, and on the 19th day of November, 1898, the answer thereto was filed, setting up that the said composition had been patented in England, and that said patent had been forfeited in 1880, and that thereby the name "Rahtjen's" by which the article had become known during the life of the patent, had become public property. It also pleaded efforts made by the predecessors in business of said Rahtjen's American Composition Co. to obtain registered trade-marks, and successful opposition made thereto by your petitioner's predecessors in business, resulting in a disclaimer filed by the predecessors in business of said Rahtjen's American Composition Co. It also set up that said predecessors of Rahtjen's American Composition Co. had not marked the vessels containing the composition with the alleged trade-mark until the predecessors of your petitioner had entered the field. It also alleged fatal laches on the part of the Rahtjen's American Composition Co. and its predecessors. It denied unfair competition. Replication to this answer was filed on the 25th day of November, 1898, and testimony and proofs were subsequently taken by both parties to said suit.

III. That the said case was heard and determined by the said Circuit Court upon the printed pleadings, proofs and exhibits of the respective parties.

IV. That the said case of your petitioner in the said Circuit Court of the United States for the Southern District of New York was heard before and decided by the Hon. HOYT H. WHEELER, District Judge of the United States for the District of Vermont, sitting in the said Court, and the opinion of the Court was delivered by him as follows :

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

RAHTJEN'S AMERICAN COMPOSITION CO.	
vs.	In Equity.
HOLZAPFEL'S COMPOSITIONS LTD. CO.	

A motion to suppress a deposition for refusal of the witness to answer certain cross-interrogatories has been brought into the hearing. The refusal might have been corrected if the proceeding against it had been brought on while an opportunity to correct it could be afforded. Not having been so treated, the refusal would seem to be waived. The motion is, therefore, denied.

Rahtjen's composition appears to have become a valuable article of commerce, well known by that name throughout the maritime world, through Rahtjen's expired English patent and his operations under it, so that his name in connection with trade in that product is descriptive of it and not an indication of its origin as from him or under his right. The article adver-

tised for by the Government in calling for the bids which are claimed to be an infringement or unfair in competition was this product, however produced, and not the product produced by or under him. To bid for furnishing such a well-known article, by whatever name known that would describe it, would not seem to be actionable according to any established principles of law.

Let decree be entered dismissing the bill.

HOYT H. WHEELER.

V. That such proceedings were had in the said case in the said Circuit Court of the United States for the Southern District of New York, that on the 29th day of November, 1899, the said Court rendered a judgment and decree therein as follows :

At a Stated Term of the Circuit Court of the United States for the Southern District of New York, in the second Circuit, held at the Court Rooms thereof, in the City of New York, on the 29th day of November, 1899.

Present—HON. HOYT H. WHEELER, Judge.

RAHTJEN'S AMERICAN COMPOSITION COMPANY vs. HOLZAPFEL'S COMPOSITOINS COMPANY, LIMITED.	In Equity.

This cause having come on to be heard upon the pleadings and proofs of the parties hereto, at a Stated Term of this Court, and having been argued by counsel for the respective parties hereto, and due deliberation and consideration having been had thereon ;

Now, on motion of Mc Adoo & Mc Adoo, solicitors for the defendant above named, it is

Ordered, adjudged and decreed, that the complainant's said bill of complaint be, and the same hereby is, dismissed.

And it is further ordered, adjudged and decreed, that the defendant has not violated or infringed any trade-mark or trade-name rights of the complainant.

And it is further ordered, adjudged and decreed, that "Rahtjen's Composition" has become a valuable article of commerce, well known by that name throughout the maritime world, through Rahtjen's expired English patent and his operations under it, so that his name in connection with trade in that product is descriptive of it, and not an indication of its origin as from him or under his rights.

And it is further ordered, adjudged and decreed that the defendant recover of the above-named complainant the cost of this suit, and that said defendant have execution therefor.

HOYT H. WHEELER.

Approved as to form.

TRACY, BOARDMAN & PLATT,
Complainant's Solicitors.

VI. That on the 1st day of December, 1899, the Rahtjen's American Composition Co., the complainant in said Court, and the respondent herein, was duly allowed by the said Circuit Court for the Southern District of New York an Appeal from its said decree to the United States Circuit Court of Appeals for the Second Circuit, and it was ordered by the Court that a certified transcript of the record and of all proceedings in the said case be forthwith transmitted to the said United States Circuit Court of Appeals for the Second Circuit.

VII. That on the 5th day of December, 1899, a transcript of the record and of all proceedings of the

Circuit Court of the United States for the Southern District of New York, in the said case, was filed in the United States Circuit Court of Appeals for the Second Circuit, and the said case was entered and docketed in the said Circuit Court of Appeals, and entitled "Rahtjen's American Composition Company, complainant and appellant, vs. Holzapfel's Compositions Co., Ltd., defendant and appellee, No. 119."

The assignment of errors filed on behalf of the Rahtjen's American Composition Co., appellant in said Court, and respondent herein, was as follows:

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

RAHTJEN'S AMERICAN COMPOSITION COMPANY, Complainant, vs. HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED, Defendant.	In Equity.

Assignment of Errors.

The Rahtjen's American Composition Company, complainant and appellant, makes the following assignment of errors in the above-entitled cause and in the decree entered therein:

(1) That said Circuit Court erred in that it ordered, adjudged and decreed that the "Rahtjen's Compositions" have become a valuable article of commerce well known by that name throughout the maritime world, through Rathjen's unexpired English patent and his operations under it, so that his name in connection

with trade in that produce is descriptive of it and not an indication of its origin as from or under his rights.

(2) That said Circuit Court erred in that it ordered, adjudged and decreed that the defendant has not violated or infringed any trade-mark or trade-name rights of the complainant.

(3) That the Circuit Court erred in that it ordered, adjudged and decreed that the bill of complaint be dismissed.

(4) That said Court erred in that it ordered, adjudged and decreed that the defendant should recover from the complainant the costs of the suit.

(5) That said Court erred in that it did not order, adjudge and decree that the trade-mark "Rahtjen's Composition" is a good and valid trade-mark, and that the complainant has exclusive right to use the same throughout the United States.

(6) That the said Circuit Court erred in that it did not order, adjudge and decree that the defendant has infringed said trade-mark and complainant's exclusive rights to the use of the same.

(7) That said Circuit Court erred, in that it did not order, adjudge and decree that the defendant has been guilty of unfair competition in business with the complainant.

(8) That said Circuit Court erred, in that it did not order, adjudge and decree that said defendant, its agents, servants and employees and any and all claiming and holding through or under it to be forever enjoined and restrained from infringing upon the said exclusive rights of the complainant in manner and form as prayed in said bill of complaint.

(9) That said Circuit Court erred, in that it did not order, adjudge and decree that said defendant pay to the complainant its unlawful profits and income by it derived and diverted from complainant in and by its infringing acts and unfair competition in business, and the damages sustained by the complainant by reason of said acts, together with the costs of this suit, and

that an accounting be had to assess the amount of the same.

Dated New York City, November 29, 1899.

TRACY, BOARDMAN & PLATT,
Solicitors for Complainant-Appellant,
35 Wall Street,
New York City.

VIII. The case came on to be heard in the said Circuit Court of Appeals for the Second Circuit on the 28th day of February and the 1st day of March, 1900, before the Hon. WILLIAM J. WALLACE, E. HENRY LACOMBE and NATHANIEL SHIPMAN, Circuit Judges; and on the 11th day of April, 1900, the said Court, by SHIPMAN, Judge (LACOMBE, Judge, concurring) rendered an opinion reversing the said decree of the Circuit Court of the United States for the Southern District of New York as follows:

UNITED STATES CIRCUIT COURT OF APPEALS,

SECOND CIRCUIT.

RAHTJEN'S AMERICAN COMPOSITION COMPANY

vs.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED.

SHIPMAN, C. J.:

John Rahtjen invented in Germany, between the years 1860 and 1865, paints specially prepared to protect the hulls of steel and iron ships from rust, and also from becoming covered by growths animal or vegetable in character. In connection with his sons he began, in 1865, to manufacture for general use, and the paints

speedily acquired a high reputation in the maritime world under the name of Rahtjen's Composition. After his death, in 1873, the business was continued in Germany by his sons, and is now carried on by John Rahtjen and Heinrich Rahtjen under the firm name of "John Rahtjen." In 1869 the Rahtjens made Henry Gelien, of Hoboken, their exclusive agent to sell their paint in the United States, with the provision that it shall be brought on the market under the name of "Rahtjen's Composition," and with the information that no patent would be applied for in this country. Gelien issued a show card for the purpose of advertising the paint under its trade-name, copyrighted the card, advertised the paint in other ways and sold it under this trade-name, to the extent of about $17,500, until the end of 1877, when he was succeeded by Hartmann, Le Doux & Maecker. In January, 1878, Suter Hartmann & Co., of London, were appointed sole agents for the sale of the paint in this country, for whom the Hartmann firm acted as sub-agents for a time. The Suter Company was succeeded in 1888 by Suter, Hartmann & Rahtjen Composition Company, Limited, which was succeeded in 1891 by the Complainant corporation, which was organized under the laws of the State of New York. During the entire period for 1869 to the commencement of this suit, the goods were continuously advertised and sold under the name Rahtjen's Composition, and the value and commercial importance of the article which Rahtjen originated, and which, as made by his firm and their successors and sold in this country, has been distinctly and widely known. The packages which came to this country from 1869 to July, 1879, were sent from Germany and were marked "Rahtjen's Composition" or "Rahtjen's Patent Composition." From 1879 to 1883 upon each package which came to this country from the complainant's predecessors was stenciled the words Rahtjen's Com-

position in some form. Since 1883, the drums which contain the paint have been marked

"Genuine
Rahtjen's Composition
Trade (Symbol of open hand) Mark.
Hartmann's
Manufacture."

The origin of the words Hartmann's Manufacture will be stated hereafter.

The complainant's gross business in this paint in 1897 was $128,300; in 1898 was $145,200, and in the last six months of 1898 was $106,000.

The firm of John Rahtjen has continued to manufacture in Germany without patent protection. In 1871 the English firm of Suter, Hartmann & Co. was formed to sell Rahtjen's Composition in England, and became the sole agents of the firm of John Rahtjen for that purpose. All the paint was manufactured in Germany by the Rahtjens until 1874, when they built a factory in Liverpool, having obtained on November 29, 1873, an English patent for the product. They continued the manufacture in Liverpool until February, 1880, when they assigned their leasehold interest in the factory and the patent and the exclusive right to manufacture the paints for sale in Great Britain and the United States to Hartmann Brothers, who carried on the manufacture under an agreement with the Rahtjens from 1880 until Suter, Hartman & Rahtjen's Composition Co., Limited, was formed in 1888. Suter, Hartmann & Co. remained the salesman until 1888, when the corporation became both the manufacturers and the vendors. The English patent, which was apparently the only one ever taken out for the paint, was forfeited for nonpayment of dues on November 29, 1880.

During the manufacture by Hartmann Brothers, the Rahtjens were also manufacturing in Germany, and to

distinguish the English product, Hartmann Brothers marked their drums Hartmann's Manufacture, and adopted in 1883 an open hand usually colored red with the word "Composition" above and the words "Hartmann's Manufacture" below the hand as their trade-mark for all their paints, including Rahtjen's. Suter, Hartmann & Rahtjen Composition Co., Limited, obtained the same trade-mark in the United States in 1889. Hartmann, Le Doux & Maecker had obtained a United States trade-mark in 1885 for the words "Rahtjen's Composition." The complainant is the owner of the good-will and trade-mark rights of its predecessors, and is their successor in ownership thereof. The assignment of the trade-mark of 1885 by Hartmann, Le Doux & Maecker to Hartmann Brothers was not apparently acknowledged, and has not been proved by the witness to the signature. In 1883, after the Rahtjen's patent expired, three brothers, under the name of Holzapfel & Co., commenced to manufacture Rahtjen's Composition in connection with their other paints, and in 1899 became a joint stock company under the name of Holzapfel's Composition Co., Limited, which was organized under the laws of Great Britain, and is the defendant. A. C. Holzapfel, who joined them in 1887, had been from 1875 to November, 1881, an agent of Suter, Hartmann & Co., or connected with them or with a member of that firm in the sale of Rahtjen's Composition.

In 1890, the defendant or its predecessors began to send its Rahtjen's Composition and other paints to John A. Donald & Co., of New York, for sale, and in 1894, the defendant took the business and has since carried it on in this country in its own name. It manufactures and sells other paints, the leading brand being called the "International," which kind it makes special effort to sell. The business of the defendant in the United States from 1890 to 1895, including a few small invoices sent to different persons from 1883 to 1890, amounting to about 92 hundred weight, was a

fraction over 2,142 hundred weight. It has always been sold as Rahtjen's Composition, Holzapfel's manufacture and no effort has been made to conceal the fact that the defendant was the manufacturer. After the English patent expired, the successors of Rahtjen attempted to obtain an English trade-mark bearing the name of Rahtjen, but were unable to do so except upon a disclaimer of an exclusive use of the words "Rahtjen's Patent Composition for ships, bottoms, buoys, &c., or of any of such words except as a part of the combination constituting our trade-mark."

Although minor issues of fact were presented in the proofs, the facts which have been recited are those of chief importance in the case, with the exception of those bearing upon the question of laches.

The defendant's case rests mainly upon the position that, after the forfeiture in 1880 of the English patent of 1873, the name Rahtjen's Composition became generic in this country, and the article could be manufactured and sold in this country by any person who described himself as the manufacturer. Reliance is placed upon the case of Singer Mfg. Co. v. June Mfg. Co., 163 U. S., 169.

It appears that the firm of John Rahtjen introduced their paint into this country in 1869 and preferred not to attempt to obtain the protection of a patent, but to gain both reputation and protection by the character of the article, and for that purpose required that it should be sold as their product, and under a trade designation. That system has been continued by each owner of the business in this country to the present time, and the name of the inventor has become fastened upon the products. If a trade-mark exists in this country in the name of Rahtjen's Composition, the complainant is the owner of it by virtue of the right of succession, as stated in the well known case of the Lepage Co. vs. Russia Cement Co., 51 Fed. Rep., 941:

> "It is equitable that a manufacturer or dealer who has given reputation to any article should

> have the privilege of realizing the fruits of his labors by transmitting his business and establishment, with the reputation which has attached to them, on his decease to his legatees or executors, or during his lifetime to purchaser, and it is also in accordance with the principles of law, and with justice to the community, that any trade-mark including a surname, may be sold with the business of the establishment to which it is incident; because, while it may be that this is ordinarily made permanent as a part of the entire organization, or as appurtenant to the locality in which the business is established, and thenceforward depends less on the individual efforts of the originator than on the combined result of all which he created."

It further appears that after 1869, the only patent which was ever taken out in any country for the paint was the English patent of 1873, which lapsed by Hartmann & Brothers' nonpayment of dues in 1880. The asserted consequence is that because the name then became *publici juris* in Great Britain it became public property everywhere. There was in 1880 a valid trade-mark right in the United States which Rahtjens and their successors had acquired. The lapse of the English patent neither broke this trade-mark, nor interfered with the title of its owners. They owned it, and although the lapse of the English patent interfered very seriously with their title to exclusive rights in Great Britain, it was ineffectual upon title in another country. In England the Rahtjens undertook to acquire exclusive rights by virtue of the patent laws. In the United States they had previously acquired exclusive rights by the common law. Their failure in England does not cause a cessation of their common law rights in the United States. The lapse of the English patent could not cause a lapse of trade-mark rights throughout the world.

The Singer case, *supra*, had exclusive reference to the continuance of a monopoly in this country upon

which letters patent of this country had expired, and the court held that the right to use the name passed to the public in this country, with the expiration of the exclusive right created by the patent to make and sell the article. The decision followed the previous general course of decisions in the Courts of this country and elsewhere, but it did not relate to the facts of this case, as obviously appears, in the opinion of Mr. Justice WHITE, who spoke for the court. In the Scotch and English and French sewing machine cases for an injunction against the use of the name of the maker, wherein the injunction had been granted such machines had not been patented in those countries. In the French case of Howe, H., where the French courts enjoined the use of that name on a sewing machine, the court as a basis of its decree, used the following language: "And whereas, they (Howe and his heirs) did not take patents in France for the invention and their improvements, which have, therefore, fallen into the public domain, and have never, either expressly or tacitly, abandoned the right to affix his name (that of Howe) to the products of the invention" (Singer case, *supra*, pp. 195, 196, 199). It is a matter of common knowledge that Howe took out patents upon his machine and its improvements in this country.

Attention is called by the defendant to two continental decisions—one of the Brussels Court of Appeals, and the other of the Criminal Chamber of the "Land" Court at Hamburg—in cases respecting the exclusive right of the Rahtjens to the trade-mark. The Brussels decision was based upon the fact, as found, that in Belgium the name indicated an article, and not the maker. The attempt is made in this case to show that in the public mind in this country the name of Rahtjen's Composition is a descriptive name, which is understood to designate a thing, and not its origin—as, for example, the word "Hansom," when applied to a cab, now means simply a particular style of vehicle.

We are not able to find from the record, as a fact, that in the United States the name Rahtjen's Composition has become a generic name, and now means a compo ition made by any one after the original formula of Rahtjen. A few witnesses say that they supposed that the complainant and the defendant were competitors in the manufacture of an article called by the same name, but the testimony does not show that the fact exists in this country, which was found by the Brussels Court of Appeals, that, " in the eyes of the public, this name of Rahtjen has become a sort of qualifying adjective, indicative of his special produce."

The Hamburg case was a criminal one, founded upon a criminal statute, and the representatives of Holzapfel were not found to have committed the offense which was defined by the existing statute, and which was, in substance, having knowingly made untrue statements of fact.

The defendant next insists that the complainat's laches should prevent any decree in its favor. It is true that the defendant has sold its manufacture of Rahtjen's Composition to a certain extent since 1890, but the sales have been comparatively small, and did not interfere with the complainant's business to any marked extent until the defendant obtained a contract with the Naval Department of the U. S. Governmentin answer to a call for offers of " Rahtjen's Composition," when suit was promptly commenced. The defendant's chief brand of paint is the " International Composition " and it has been their endeavor to sell that brand, if they could, and, failing that, Rahtjen's Composition. The defense of laches is nominal rather than real, for the defendant's interference with the property rights of the plaintiff was, for many years, inconsiderable, and, under no decision, merits a refusal of a decree of injunction.

Under all the circumstances of the case, we are not inclined to direct a decree for an accounting.

The decree of the Circuit Court is reversed with

costs, and the case is remanded to that Court with instructions to enter a decree, enjoining the defendant from selling or offering to sell paint under the name of Rahtjen's Composition, and from using that name upon its packages or in its advertisements as belonging to paint of its manufacture, in accordance with the foregoing opinion, and for costs of that Court.

WALLACE, Circuit Judge, delivered a dissenting opinion as follows:

UNITED STATES CIRCUIT COURT OF APPEALS.

SECOND CIRCUIT.

RAHTJEN'S AMERICAN COMPOSITION COMPANY

vs.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED.

WALLACE, Circuit Judge:

I dissent from the opinion of the Court. I am of the opinion that the alleged trade-mark of the complainant is public property, first, because the name was the generic description of a patented article and passed to the public upon the expiration of the patent, and, secondly, because the name has long ceased to denote the source of the manufacture of the article.

Rahtjen and his sons were the original manufacturers and sellers in Germany of an article which they called "Rahtjen's Composition," made after a formula originated by one of them, and having properties peculiarly useful for preserving the hulls of vessels. In November, 1873, Rahtjen obtained a patent in England for the article. "Rahtjen's Composition" gradually became known to the maritime world as the name of an

article made according to the formula of the patent. The monopoly under the English patent expired in 1880. Thereafter the article was made and sold by manufacturers by the name of Rahtjen's Composition in England and on the continent, and the name ceased to designate any particular source of manufacture. The successors of the original manufacturers, who had acquired the sole right to manufacture and sell the article in England, when they applied there for the registration of a trade-mark for the article, disclaimed the exclusive right to that name.

When they sought, in 1886, to prevent manufacturers in Belgium from selling the article as Rahtjen's Composition, the Belgian courts refused relief, deciding that any person who did not represent the article as purporting to be manufactured by the Rahtjens or their successors in business had a right to sell it under the name by which it had become generally known. I am at a loss to understand why any different decision should be made in this country, but the court seems to be of opinion that the name is a good trade-mark here, because no patent was ever obtained for the article in this country, and because the successors in business of Rahtjen have always sold it here under the name originally applied to it. This means that a man can have a trade-mark in this country in a name which is common property everywhere else. If this is good law, then any person here buying in Belgium, or elsewhere in Europe, or in England, the article known as Rahtjen's Composition, can be prevented from dealing in it here under the name by which he bought it. So long as Rahtjen and his associates and successors in business enjoyed a monopoly of the manufacture of the article, the name not only identified the characteristics of the article, but also denoted the source of manufacture; but when the monopoly ceased, and the article passed into the domain of public property, the name which had been its generic designation also passed. Their monopoly has ceased to exist in

this country as well as abroad, and the property in the name can no more survive here than it can abroad.

Irrespective of the effect of the expiration of the patent, the designation has become *publici juris* through its long use by dealers in the article which it describes, and whether this is attributable to the acquiescence of the complainant and its predecessors, or to their laches, is immaterial, since their conduct, active or passive, has led to the result.

One test by which to determine whether a word which was originally a trade-mark has become *publici juris* is whether the use of it by persons other than the original owner is still calculated to mislead the public and induce them to buy goods not made by the original owner upon the supposition that they are his goods. Whenever the name has come to be so generally understood by the public dealing in the article as denoting the article itself that nobody can be deceived by the use of it into the belief that it was made by any particular person, the right to it as a trade-mark is gone (Ford vs. Foster, L. R., 7 Ch. App., 611). If that test is applied to this case, there can be no doubt the name is no longer a valid trade-mark.

There is no pretense that the defendants have represented their article to be the manufacture of the complainants, or of their predecessors in business.

I think the case was properly decided in the court below, and that the decree should be affirmed.

IX. On the 23rd day of April, 1900, the said Circuit Court of Appeals made and entered an order for a mandate, as follows:

At a Stated Term of the United States Circuit Court of Appeals for the Second Circuit, held in the Court Rooms thereof in the United States Post Office Building, in the City of New York, on the 23rd day of April, 1900.

Present—

HON. WILLIAM J. WALLACE,
E. HENRY LACOMBE,
NATHANIEL SHIPMAN,
Circuit Judges.

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Complainant-Appellant,

vs.

HOLZAPFEL'S COMPOSITIONS COMPANY, LTD.,
Defendant-Appellee.

The appeal from a decree of the Circuit Court of the United States for the Southern District of New York, made herein on the first day of December, 1899, having come on to be heard and due deliberation having been had thereon :

Now, on motion of William McAdoo, of counsel for appellee, it is

Ordered, that the decree aforesaid be, and the same hereby is, in all things reversed ; and it is further

Ordered, that a mandate issue to the Circuit Court of the United States for the Southern District of New York, directing the Court to enter a decree in accordance with the prayer of the bill of complaint herein, except that no accounting for damages or profits shall be ordered, and for costs in this Court and in said

Circuit Court, all in accordance with the opinion of this Court.

N. S.

E. H. L.

X. A certified copy of the entire record of the said case in the said Circuit Court of Appeals is herewith furnished and hereto annexed as part of this application, in conformity with Rule 37 of this honorable court, relative to cases from Circuit Court of Appeals, and the same is marked "Exhibit A."

XI. Your petitioner is advised and believes that the said judgment and decree of the said United States Circuit Court of Appeals for the Second Circuit, in the said case is erroneous, and that this honorable court should require the said case to be certified to it for its review and determination under and in conformity with the provisions of the Sixth section of the Act of Congress entitled "An Act to establish Circuit Court of Appeals, and to define and regulate in certain cases the jurisdiction of the Courts of the United States and for other purposes," approved March 3, 1891.

XII. The said case was decided in the said United States Circuit Court of Appeals for the Second Circuit, upon the supposed recognition of the said doctrine by this honorable court, in the case of The Singer Mfg. Co. v. June Mfg. Co., 163 U. S., 169, but the question presented by and involved in the said case of the petitioner was not presented by or involved in the case of The Singer Mfg. Co. v. June Mfg. Co., and the question was not decided in that case, nor was the decision of the same necessary for the determination of that case by this honorable court.

XIII. That the question whether a common law trademark in the name of an article, is or is not affected in this country by the expiration or lapse of a foreign

patent on said article, has never been judicially determined by any court, prior to the said suit against your petitioner.

XIV. The importance and gravity of this case to your petitioner will be recognized from the fact that through the decree of the United States Circuit Court of Appeals your petitioner will be forever enjoined from using the word "Rahtjen," thereby ending an established business which your petitioner has built up through very many years.

Your petitioner claims:

FIRST. That when a name under which an article has become known in the country in which it was patented, becomes public property there, by reason of the expiration of the patent, it becomes public property the world over (except in such countries where there may be valid, existing patents, on said article, unaffected by the term of the foreign patent).

SECOND. That, under the circumstances stated in the foregoing claim, the right to manufacture the article, and sell it as being made in accordance with the expired patent, has become public property and open to the entire world.

THIRD. That if the respondent ever acquired a common law trade-mark in the United States, such trade-mark became public property when the English patent expired.

FOURTH. That the respondent cannot have a common law trade-mark in the United States in a name which has become public property abroad.

FIFTH. That the name "Rahtjen's Composition" has become the generic description of a patented arti-

cle and passed to the public on the expiration of the patent.

SIXTH. That the name "Rahtjen's Composition" has long ceased to denote the source of manufacture.

SEVENTH. That the respondent, having stood silently by for very many years and allowed the petitioner's predecessors to build up an established business in "Rahtjen's Composition," and the business having been subsequently incorporated with a large capital and numerous new stockholders, is forever estopped from enjoining or interfering with the petitioner's use of the word "Rahtjen's."

EIGHTH. That the sale by the predecessors in business of the Rahtjen's American Composition Company was not large enough, or conducted for a long enough period in the United States, for the said company to have acquired a common-law trade-mark in the United States prior to the application for the English Patent.

NINTH. That the act of the predecessors of the respondent in disclaiming the exclusive use of the word "Rahtjen" when they applied for the registration of a trade-mark in England estops them from claiming such exclusive right now in this country.

Wherefore, your Petitioner respectfully prays that a writ of *certiorari* may be issued out of and under the seal of this court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding the said Court to certify and send to this Court on a day certain, to be therein designated, a full and complete transcript of the record and all proceedings of the said Circuit Court of Appeals in the case entitled "Rahtjen's American Composition Co., complainant and appellant, vs. Holzapfel's Compositions Company, Limited, Defendant and Appellee, No. 119," to the end

that the said cause may be reviewed and determined by this Court, as provided in section 6 of the Act of Congress entitled "An act to establish Circuit Courts of Appeals and to define and regulate in certain cases the jurisdiction of the Courts of the United States, and for other purposes," approved March 3, 1891, or that your petitioner may have such other or further relief or remedy in the premises as to this Court may seem appropriate, and in conformity with the said act, and that the said judgment and decree of the said Circuit Court of Appeals for the Second Circuit, in the said case, awarding an injunction and costs, may be reversed by this honorable court.

And your petitioner will ever pray, &c.

Holy apple Compositions Company Limited
John A Lendld
manager

William Mc Adoo
Solicitor and Counsel Petitioner.

We certify that in our opinion the above petition is well grounded in matter of law and proper to be heard.

John G Carlisle

William Mc Adoo.
Of Counsel for Petitioner.

STATE OF NEW YORK, }
County of New York, } ss.:

JOHN A. DONALD, being duly sworn, says that he is an officer, to wit: the manager in the United States of the Holzapfel's Compositions Company, Limited, the petitioner above named; that he has read the foregoing petition and knows the contents thereof, and that the facts therein stated are true to the best of his information and belief.

Sworn to and subscribed before me this 3rd day of May, 1900. } John A Donald

Robert L. Maroney
Notary Public
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N.Y. Co.

{Notarial Seal}